

REMARKS

Upon entry of the foregoing Amendment, claims 180-184, 186-189, 194-202, 204-207, 212-217 are pending in the application. Claims 180-184, 186-189, 194-202, 204-207, 212-217 have been amended. Claims 185, 190-193, 203, and 208-211 have been cancelled without prejudice or disclaimer. No claims have been newly added. The Specification has been amended to include a cross-reference to related applications. Applicants believe that this Amendment does not add new matter. In view of the foregoing Amendment and the following Remarks, allowance of all the pending claims is requested.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner has rejected claim 189 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Examiner alleges that Applicants' disclosure does not support the feature "wherein the data received from the vendor-controlled postage-issuing computer system further verifies consistency between the certificate serial number contained in the postage indicium and a digital signature derived from the tracking identifier further contained in the postage indicium."

Solely to expedite prosecution of this application, and without acknowledging the propriety of the alleged basis for the rejection, Applicant has amended claim 189 to further clarify the various features recited therein. In particular, claim 189 has been amended to recite, among other things, "verifying consistency between [a] public key corresponding to the certificate serial number and a digital signature associated with the postage indicium carried on the current mail piece." For example, on page 53, lines 11-19, Applicants' disclosure describes techniques whereby a postage indicium may be validated based on whether a digital signature and a public key corresponding to a certificate serial are consistent.

Accordingly, amended claim 189 satisfies the written description requirement for at least the reason that Applicants' disclosure supports the features recited therein. As such, Applicants respectfully request that the Examiner withdraw this rejection.

REJECTION UNDER 35 U.S.C. § 103

A. CLAIMS 180-184, 187-189, 194-202, 205-207, AND 212-217

The Examiner has rejected claims 180-184, 187-189, 194-202, 205-207, and 212-217 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 6,527,178 to Gordon et al. ("Gordon") in view of U.S. Patent No. 6,925,451 to Bailey et al. ("Bailey"), or alternatively over Gordon in view of material in Applicants' disclosure that the Examiner alleges to be admitted prior art ("APA"). These rejections are improper and must be withdrawn for at least the reason that Gordon and Bailey, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest each and every feature of the claimed invention.

More particularly, Gordon and Bailey, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest at least the combined features that include "maintaining a transaction database that stores tracking identifiers associated with mail pieces that a postage validation computer system previously validated or rejected, wherein the tracking identifiers associated with the previously validated or rejected mail pieces provide a delivery status tracking capability within the United States Postal Service," "reading, at the postage validation computer system, a postage indicium carried on a current mail piece, wherein the postage indicium contains a certificate serial number and a tracking identifier associated with the current mail piece," and "validating or rejecting the postage indicium carried on the current mail piece based on the postage validation computer system comparing the tracking identifier associated with the current mail piece to the tracking identifiers stored in the transaction database, wherein the United States Postal Service submits the current mail piece for normal delivery if the postage validation computer system validates the postage indicium carried on the current mail piece" as recited in amended independent claim 180, for example.

The Examiner alleges that Gordon discloses the United States Postal Service reading a postage indicium that contains a tracking identifier from a mail piece and validating the postage indicium in response to the tracking identifier contained therein not matching any records in a transaction database that stores tracking identifiers contained in postage indicia associated with previously handled mail pieces. Applicants disagree with the Examiner's

assessment for at least the reason that the Examiner has mischaracterized the nature of the “transaction or serial number” described in Gordon, in that Gordon does not disclose, teach, or suggest that the “transaction or serial number” described therein provides “a delivery status tracking capability within the United States Postal Service.” Rather, Gordon generally describes “authenticating mail pieces utilizing *cryptographically secured* or *plain text indicia* printed on the mailpiece as evidence of postage payment,” wherein as “each subsequent mailpiece is processed by the postal authority, its *indicia* serial or transaction number will be compared to the master database to determine if an identical *serial or transaction number* already exists therein” (Abstract, col. 3, lines 13-26).

In other words, the “serial or transaction number” described in Gordon relates, at best, to a certificate serial number issued from an Information Based Postage Indicium Certificate Authority, which the United States Postal Service permits to be printed on mail pieces “as evidence of postage payment” (Abstract). On the other hand, the claimed “tracking identifier” provides a different function within the United States Postal Service, namely, “a delivery status tracking capability” to track a status associated with the United States Postal Service delivering a mail piece carrying the tracking identifier. As such, to the extent that Gordon describes comparing serial or transaction numbers in a master log database to serial or transaction numbers read from scanned indicia to identify potentially counterfeit indicia, the “serial or transaction numbers” have different functions and different representations from the claimed “tracking identifiers” that “provide a delivery status tracking capability within the United States Postal Service.” Accordingly, the Examiner has improperly conflated the “serial or transaction number” described in Gordon with the claimed “tracking identifier.”

In response to Applicants’ previous arguments addressing these distinctions over Gordon, the Examiner alleges that features relating to “intended use . . . must result in a structural difference between the claimed invention and the prior art” and that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.” To support these allegations, the Examiner apparently concedes that “Gordon does not expressly disclose” the features that Applicants have previously emphasized, the Examiner alleges that “these differences are only found in the nonfunctional descriptive material and are not functionally

involved in the steps recited” and that the “information collection and storage steps would be performed the same regardless of the data.” Office Action, pages 15-16. Applicants initially note that the Examiner continues to focus on the language “certificate serial number” and thus apparently fails to appreciate that Applicants have consistently emphasized these differences in a context that relates to distinctions between the claimed “tracking identifiers,” which provide a mail piece tracking capability, and “serial or transaction numbers,” which evidence postage payment. Thus, the Examiner’s arguments have little or no relevance to the arguments that Applicants have previously submitted, for the Examiner is clearly continuing to apply an incorrect interpretation to the features that relate to using a “tracking identifier” to validate a postage indicium that contains the same.

Nonetheless, even setting aside the Examiner’s incorrect interpretation of the claim language, the Examiner’s arguments erroneously allege that the emphasized “differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited” and that the “information collection and storage steps would be performed the same regardless of the data.” For example, Applicants’ disclosure describes various differences in how the United States Postal Service handles postage indicia and tracking identifiers. In particular, Applicants’ disclosure indicates that “[u]nlike the two dimension IBI postage indicia barcodes, these standard tracking [identifiers] . . . are typically scanned 100% of the time” (page 16, lines 3-5). Thus, because the United States Postal Service tends to always scan tracking identifiers that provide delivery status tracking capabilities, while “the self-validating postage indicia on tracked mail pieces are [usually] only spot-checked,” “the ideal unique character string for the indicium is the tracking [identifier] itself” (page 15, lines 16-22). To that end, the claimed “tracking identifiers” are indeed “functionally involved in the steps recited,” contrary to the Examiner’s assertions, for amended independent claim 180 recites features that relate to storing the tracking identifiers in a transaction database, obtaining a tracking identifier from a postage indicium carried on a current mail piece, and comparing the tracking identifiers in the transaction database to the tracking identifier associated with the current mail piece to validate the postage indicium associated therewith.

As such, whereas amended independent claim 180 recites various features that can validate postage indicia with “tracking identifiers” contained therein to detect potential copy fraud, Gordon only describes extracting “the indicia transaction or serial number [] from the scanned indicia . . . to locate the database entry for the scanned indicia transaction or serial number” (col. 8, lines 10-14). For at least these reasons, Gordon does not disclose, teach, or suggest the aforementioned features recited in amended independent claim 180, which relate to validating a postage indicium based on “*a tracking identifier*” contained therein that provides a delivery status tracking capability within the United States Postal Service. In this context, Applicants remind the Examiner that functional features “must be evaluated and considered, just like any other limitation of the claim,” for what such features fairly convey to a person having ordinary skill in the art. Thus, because settled law unambiguously provides that functional features can properly recite particular capabilities or purposes that such features serve, the Examiner’s allegations regarding the alleged lack of structural distinctions have no merit. *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20 (Fed. Cir. 2004); *see also* MPEP § 2173.05(g).

Bailey fails to cure the foregoing deficiencies of Gordon for at least the reason that the Examiner has only relied upon Bailey as allegedly disclosing a unique tracking identifier that provides a mail piece tracking capability within the United States Postal Service. However, even assuming *arguendo* that the Examiner has correctly characterized Bailey, which Applicants do not concede, a unique tracking identifier alone does not fairly disclose, teach, or suggest using the unique tracking identifier in a context that relates to validating a postage indicium based on whether the tracking identifier matches any records in a transaction database that stores tracking identifiers contained in postage indicia located on mail pieces that have been previously validated or rejected. Applicants note that to the extent that Bailey may generally describe tracking identifiers, the Examiner has consistently overlooked the functional relationship that the claimed “tracking identifier” has in the various claim features, which relates to the United States Postal Service determining whether or not to submit a mail piece for normal delivery based on the status associated with previously handled tracking identifiers. Indeed, the fact that the Examiner alleges that “these differences . . . are not functionally

involved in the steps recited” clearly shows that the Examiner has failed to properly consider the claimed invention as a whole. As such, for at least these reasons, Bailey fails to cure the foregoing deficiencies of Gordon.

In addition, the alleged APA fails to cure the foregoing deficiencies of Gordon for at least the reason that the Examiner has only relied upon the alleged APA as disclosing that certificate serial numbers and tracking identifiers with tracking capabilities are old and well known. However, even assuming *arguendo* that the Examiner has correctly characterized the description in Applicants’ disclosure as APA, which Applicants do not concede, Applicants’ disclosure contains no admissions that using tracking identifiers with tracking capabilities in the claimed context was well known. For example, independent claim 180 recites various features that relate to validating a postage indicium located on a mail piece based on whether a tracking identifier contained therein matches tracking identifiers associated with previously validated or rejected mail pieces. In other words, even assuming *arguendo* that postage indicia containing certificate serial numbers or tracking identifiers are known, Applicants’ disclosure contains no admissions that such features were known in a context where the United States Postal Service submits a mail piece for normal delivery if the mail piece carries a postage indicium containing a tracking identifier that does not match any tracking identifiers associated with previously validated or rejected mail pieces. Thus, the alleged APA fails to cure the foregoing deficiencies of Gordon for at least this reason.

Accordingly, for at least the foregoing reasons, Gordon and Bailey, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest each and every feature recited in amended independent claim 180. The rejection is therefore improper and must be withdrawn.

Independent claim 198 has been amended to recite features similar to those set forth in amended independent claim 180. Claims 181-184, 187-189, 194-197, 199-202, 205-207, and 212-217 depend from and add features to one of amended independent claims 180 and 198. Thus, the rejection of these claims is likewise improper and must be withdrawn for at least the same reasons.

B. CLAIMS 186 AND 204

The Examiner has rejected claims 186 and 204 under 35 U.S.C. § 103 as allegedly being unpatentable over Gordon in view of Bailey, and further in view of U.S. Patent Application Pub. No. 2002/0152174 to Woods et al. (“Woods”), or alternatively over Gordon in view of the alleged APA and “Information-Based Indicia Program” to the United States Postal Service (“USPS”). These rejections are improper and must be withdrawn for at least the reason that the references relied upon, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest each and every feature of the claimed invention.

More particularly, for at least the reasons discussed above, Gordon and Bailey, either alone or in combination with the alleged APA, fail to disclose, teach, or suggest at least the combined features that include “maintaining a transaction database that stores tracking identifiers associated with mail pieces that a postage validation computer system previously validated or rejected, wherein the tracking identifiers associated with the previously validated or rejected mail pieces provide a delivery status tracking capability within the United States Postal Service,” “reading, at the postage validation computer system, a postage indicium carried on a current mail piece, wherein the postage indicium contains a certificate serial number and a tracking identifier associated with the current mail piece,” and “validating or rejecting the postage indicium carried on the current mail piece based on the postage validation computer system comparing the tracking identifier associated with the current mail piece to the tracking identifiers stored in the transaction database, wherein the United States Postal Service submits the current mail piece for normal delivery if the postage validation computer system validates the postage indicium carried on the current mail piece” as recited in amended independent claim 180, for example.

Woods fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA for at least the reason that the Examiner has only relied upon Woods as allegedly disclosing techniques that relate to generating and sending tracking identifiers to a postage vendor to enable tracking for mail pieces delivered through the United States Postal Service. However, even assuming *arguendo* that the Examiner has correctly characterized Woods, which

Applicants do not concede, issuing tracking identifiers to vendor-controlled postage-issuing computer systems does not disclose, teach, or suggest incorporating the tracking identifiers within postage indicia to validate whether the tracking identifiers have been duplicated, used multiple times, or used in other copy fraud scenarios. For at least this reason, Woods fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA.

In addition, USPS further fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA for at least the reason that the Examiner has similarly relied upon USPS as allegedly disclosing techniques that only relate to generating and sending tracking identifiers to a postage vendor to enable tracking for mail pieces delivered through the United States Postal Service in a manner that complies with IBIP requirements. However, even assuming *arguendo* that the Examiner has correctly characterized USPS, which Applicants do not concede, issuing tracking identifiers to vendor-controlled postage-issuing computer systems does not disclose, teach, or suggest incorporating the tracking identifiers within postage indicia to validate whether the tracking identifiers have been duplicated, used multiple times, or used in other copy fraud scenarios. For at least this reason, USPS further fails to cure the foregoing deficiencies of Gordon, Bailey, and the alleged APA.

Accordingly, for at least the foregoing reasons, the references relied upon, either alone or in combination, fail to disclose, teach, or suggest each and every feature of amended independent claim 180. Independent claim 198 has been amended to recite features similar to those set forth in amended independent claim 180. Claims 185 and 204 depend from and add features to one of amended independent claims 180 and 198. Thus, the rejections of these claims are improper and must be withdrawn for at least the foregoing reasons.

CONCLUSION

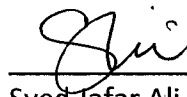
Having addressed each of the foregoing objections and rejections raised by the Examiner, Applicants respectfully submit that a full and complete response has been made to the outstanding Office Action. As such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: January 12, 2011

Respectfully submitted,

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